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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,013	05/24/2001	Sean O'Hara	035451-0135 (3648.Palm)	3782
26371	7590	09/16/2004	EXAMINER	
FOLEY & LARDNER 777 EAST WISCONSIN AVENUE SUITE 3800 MILWAUKEE, WI 53202-5308			LIEN, TAN	
			ART UNIT	PAPER NUMBER
			2141	

DATE MAILED: 09/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/865,013

Applicant(s)

O'HARA ET AL.

Examiner

Tan Lien

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/29/01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTIONS**

### ***Drawings***

The drawings were received on 8/16/2001. These drawings are acceptable.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 38 recites the limitation "the remote location" on page 25, line 1. There is insufficient antecedent basis for this limitation in the claim. The Examiner presume that claim 38 is a dependent of claim 37 and not 32, in which case the limitation "the remote location" will not lack antecedent basis.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 8-17, 20-25, 27-29, 31-34, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Costales et al (US Patent 6,044,395).

Art Unit: 2141

Claim(s) 1: Costales teaches a method of sending common information to multiple destination sources using a handheld computer, the method comprising:

selecting information in a source file (col. 2, lines 50-53; wherein the common content chunk is selected from a source file and sent to the multiple-destination recipients);

storing the selected information in memory (col. 2, lines 50-59; wherein the first portion of the e-mail is sent first and store in cache or memory waiting for the second portion to be reassembled);

selecting a remote destination (col. 2, lines 32-37; wherein every e-mail has a final destination);

adding destination-specific information to the selected information (col. 2, lines 54-57; wherein the destination-specific information is the second portion of the e-mail message containing information specific to the particular recipient); and

sending the selected and destination-specific information to the remote destination (FIG. 3, ref. 304 & 306 and col. 2, lines 50-59; wherein the selected information is the common content chunks and the destination-specific information is the individual message specific to the recipient).

Claim(s) 2: Costales teaches the method of claim 1, further comprising

creating a customizable file and automatically moving the selected information from the memory to the customizable file (col. 4, lines 40-44; wherein the server

Art Unit: 2141

inserts or automatically moves the common chunk message from cache or memory into the individual messages).

Claim(s) 3: Costales teaches the method of claim 1, wherein

the source file is an electronic mail message created by the user (col. 4, lines 32-35).

Claim(s) 4: Costales teaches the method of claim 1, wherein

the source file is a template (col. 2, lines 50-54; wherein the source file is an e-mail message template containing the common content chunks) and the selecting information step is performed automatically (col. 2, lines 54-59; wherein the selection of the common content chunks is performed automatically by the e-mail system to insert into the individual message specific to the recipient).

Claim(s) 5: Costales teaches the method of claim 1, wherein

the selected information is electronic text (FIG. 1A).

Claim(s) 8: Costales teaches the method of claim 1, wherein

selecting a remote destination includes entering a destination address (col. 2, lines 33-36; wherein the system or user has to enter the e-mail address in order for it to be routed to the final destination).

Art Unit: 2141

Claim(s) 9: Costales teaches the method of claim 8, wherein

selecting a destination further comprises selecting the destination in response to a user prompt (FIG. 5A, ref. 505 after the "TO:" prompt), wherein the user prompt automatically appears after the source file is created (FIG. 5A, ref. 507, 509; wherein the source file is created in ref. 509 and the user prompt is prompting the user to type a "." on a line by itself to end the message after the source file is created in ref. 509).

Claim(s) 10: Costales teaches the method of claim 1, wherein selecting a destination comprises

creating a group of destination addresses having a group name and selecting the group name (FIG. 3, ref. 304; wherein the common content chunks are transmitted to a group of destination addresses group by a group name selected by the sender).

Claim(s) 11: Costales teaches the method of claim 10, wherein

selecting a destination further comprises selecting the destination in response to a user prompt (FIG. 5A, ref. 505 after the "TO:" prompt), wherein the user prompt automatically appears after the source file is created (FIG. 5A, ref. 507, 509; wherein the source file is created in ref. 509 and the user prompt is prompting the user to type a "." on a line by itself to end the message after the source file is created in ref. 509).

Claim(s) 12: Costales teaches a method of customizing information contained in an electronic file using a handheld computer based on the intended recipient of the information, the method comprising:

selecting information in a first electronic document (FIG. 3 and col. 2, lines 50-53; wherein the content chunk is the first electronic document and the whole information is selected and transmitted first);

automatically generating a second electronic document (col. 2, lines 54-57; wherein the second electronic document is the first and second portion that forms a complete e-mail message, and the complete e-mail is automatically generated by inserting the content chunk into the individual message), the second electronic document including the information selected from the first electronic document (col. 2, lines 57-59);

choosing an output destination for the second electronic document (col. 2, lines 57-59; wherein each complete e-mail message has at least an output destination or recipient);

adding customized information to the second electronic document (col. 2, lines 54-59; wherein the individual message is customized information and it gets added to the common content chunk); and

delivering the second electronic document to the output destination (col. 2, lines 33-36; wherein the complete message is assembled and delivered to the final destination).

Claim(s) 13: Costales teaches the method of claim 12, wherein

at least a portion of the customized information is automatically added to the second electronic document based on the recipient (col. 2, lines 50-59; wherein the customized information or the individual message is automatically added to the content chunk based on the recipient or the individual message is specific to the recipient).

Claim(s) 14: Costales teaches the method of claim 12, wherein

the first electronic document is an electronic mail message (col. 2, lines 50-51).

Claim(s) 15: Costales teaches the method of claim 12, wherein

the source file is a template (col. 2, lines 50-54; wherein the source file is an e-mail message template containing the common content chunks) and the selecting information step is performed automatically (col. 2, lines 54-59; wherein the selection of the common content chunks is performed automatically by the e-mail system to insert into the individual message specific to the recipient).

Claim(s) 16: Costales teaches the method of claim 12, wherein

the first electronic document is a text document (FIG. 5A and 5B; wherein the first electronic document is the content chunk in the form of text).

Art Unit: 2141

Claim(s) 17: Costales teaches the method of claim 12, wherein

the selected information is an electronic text (FIG. 5A and 5B; wherein the selected information is the selected content chunk in the form of text).

Claim(s) 20: Costales teaches the method of claim 12, wherein

choosing an output destination includes entering a destination address (col. 2, lines 33-36; wherein the system or user has to enter the e-mail address in order for it to be routed to the final destination).

Claim(s) 21: Costales teaches the method of claim 20, wherein

selecting an output destination further comprises selecting the output destination in response to a user prompt (FIG. 5A, ref. 505 after the "TO:" prompt), wherein the user prompt automatically appears after the source file is created (FIG. 5A, ref. 507, 509; wherein the source file is created in ref. 509 and the user prompt is prompting the user to type a "." on a line by itself to end the message after the source file is created in ref. 509).

Claim(s) 22: Costales teaches the method of claim 1, wherein choosing an output destination comprises

creating a group of destination addresses having a group name and selecting the group name (FIG. 3, ref. 304; wherein the common content chunks are

Art Unit: 2141

transmitted to a group of destination addresses group by a group name selected by the sender).

Claim(s) 23: Costales teaches the method of claim 10, wherein

selecting an output destination further comprises selecting the destination in response to a user prompt (FIG. 5A, ref. 505 after the "TO:" prompt), wherein the user prompt automatically appears after the source file is created (FIG. 5A, ref. 507, 509; wherein the source file is created in ref. 509 and the user prompt is prompting the user to type a "." on a line by itself to end the message after the source file is created in ref. 509).

Claim(s) 24: Costales a method of conveying electronic information to members of a defined group using a handheld computer, the method comprising:

creating a distribution group including a plurality of recipients (col. 2, lines 33-36; wherein the multiple e-mail messages are in a distribution group);  
generating a first electronic file, the file including common information to be sent to at least one of the plurality of recipients (col. 2, lines 50-53 and FIG. 3, ref. 304);  
choosing a first recipient from the plurality of recipients in response to a user prompt (FIG. 5A, ref. 505 ; wherein after the "TO:" prompt the user chooses a first recipient by entering the first email address);

Art Unit: 2141

entering a first customized set of information in the electronic file tailored to the first recipient (col. 2, lines 54-57; wherein the second portion of the e-mail contains information specific to the first recipient); and  
sending the common information and the first customized set of information to the first recipient (col. 2, lines 36-37).

Claim(s) 25: Costales teaches the method of claim 24, further comprising:

choosing a second recipient from the plurality of recipients in response to a user prompt (col. 2, lines 50-53 and FIG. 3, ref. 304 & 310; wherein ref. 310 shows that the process goes on to the second recipient when the transaction is not finished);

entering a second customized set of information in a second electronic file tailored to the second recipient (col. 2, lines 54-57; wherein the second portion of the e-mail contains information specific to the second recipient); and  
sending the common information and the second customized set of information to the second recipient (col. 2, lines 36-37).

Claim(s) 27: Costales teaches the method of claim 24, wherein

the first and second electronic files are electronic mail messages (col. 2, lines 50-57 and col. 4, lines 32-35).

Claim(s) 28: Costales teaches the method of claim 24, wherein

Art Unit: 2141

the first and second electronic files are text document files (FIG. 5A and 5B;  
wherein the first electronic document is the content chunk in the form of text and  
the second electronic file is the individual message in the form of text).

Claim(s) 29: Costales teaches the method of claim 24, wherein

the common information includes electronic text (col. 2, lines 34-37 and FIG. 5A  
& 5B).

Claim(s) 31: Costales teaches the method of claim 24, wherein

the first customized set of information includes electronic text (col. 2, lines 54-59  
and FIG. 5A & 5B).

Claim(s) 32, 33: Costales teaches a handheld computer, comprising:

a processor (FIG. 2, ref. 202 and col. 3, lines 46-49);

a display coupled to the processor (FIG. 2, ref. 216 and col. 3, lines 46-49);

a memory coupled to the processor (col. 3, lines 46-49); and

a program running on the processor,

the program configured to enable a user to create an electronic template  
document having a first set of information (col. 2, lines 50-54; wherein the  
e-mail message template contains the first portion of the message or the  
first set of information),

the program configured to automatically transfer the first set of information into at least one destination-specific document (col. 2, lines 54-59; wherein the selection of the common content chunks is performed automatically by the e-mail system to insert into the individual message specific to the recipient), the program enabling the entry of destination-specific information into the at least one destination-specific document (col. 2, lines 54-59).

Claim(s) 34: Costales teaches the handheld computer of claim 32, wherein the first set of information includes electronic text (FIG. 5A and 5B).

Claim(s) 37: Costales teaches the handheld computer of claim 32, wherein the program is further configured to enable a user to send the destination-specific document to a remote location (col. 2, lines 54-57; wherein the destination-specific document is the second portion of the information and the remote location is another computer shown in FIG. 2, ref. 206).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 7, 18, 19, 30, 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Costales in view of Beck et al (US Patent 5,903,723).

Claim(s) 6, 7: Costales teaches the method of claim 1, but fails to teach

the selected information is an electronic file attachment.

Beck, in an analogous art, teaches selecting the e-mail attachments, such as a word processing file (col. 1, lines 25-26), to be sent to the recipient and storing the attachment local to the sender for future retrieval by the recipient via a reference (Abstract of Beck). It would be obvious to one of ordinary skill in the art at the time of the invention to combine Costales' method of sending common information in an e-mail message with Beck's e-mail attachment, for the advantage of efficiently utilizing processor and communications medium bandwidth and memory storage in a computer communications network (col. 1, lines 54-59).

Claim(s) 18, 19: Costales teaches the method of claim 12, but fails to teach

the selected information is an electronic file attachment.

Beck, in an analogous art, teaches selecting the e-mail attachments, such as a word processing file or text document file (col. 1, lines 25-26), to be sent to the recipient and storing the attachment local to the sender for future retrieval by the recipient via a reference (Abstract of Beck). It would be obvious to one of ordinary skill in the art at the time of the invention to combine Costales' method

Art Unit: 2141

of customizing information in an e-mail message with Beck's e-mail attachment, for the advantage of efficiently utilizing processor and communications medium bandwidth and memory storage in a computer communications network (col. 1, lines 54-59).

Claim(s) 30: Costales teaches the method of claim 24, but fails to teach

the common information includes at least one electronic file attachment, and the file attachment is at least one of an audio file, video file, a spreadsheet file, a database file, a presentation file, and a text document file.

Beck, in an analogous art, teaches including the e-mail attachments in the message, such as a word processing file or text document file (col. 1, lines 25-26), to be sent to the recipient and storing the attachment local to the sender for future retrieval by the recipient via a reference (Abstract of Beck). It would be obvious to one of ordinary skill in the art at the time of the invention to combine Costales' method of customizing information in an e-mail message with Beck's e-mail attachment, for the advantage of efficiently utilizing processor and communications medium bandwidth and memory storage in a computer communications network (col. 1, lines 54-59).

Claim(s) 35, 36: Costales teaches the handheld computer of claim 32, but fails to teach

Art Unit: 2141

the first set of information includes an electronic file, and the electronic file is at least one of an audio file, video file, a spreadsheet file, a database file, a presentation file, and a text document file.

Beck, in an analogous art, teaches including the e-mail attachments in the message, such as a word processing file or text document file (col. 1, lines 25-26), to be sent to the recipient and storing the attachment local to the sender for future retrieval by the recipient via a reference (Abstract of Beck). It would be obvious to one of ordinary skill in the art at the time of the invention to combine Costales' method of customizing information in an e-mail message with Beck's e-mail attachment, for the advantage of efficiently utilizing processor and communications medium bandwidth and memory storage in a computer communications network (col. 1, lines 54-59).

Claims 26 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Costales in view of Siitonen et al (US Patent 6,049,796).

Claim(s) 26: Costales teaches the method of claim 24, but fails to teach

the common information is stored in the dynamic memory of a handheld computer.

Siitonen, in an analogous art, teaches a PDA using an E-mail application (Abstract and FIG. 5B of Siitonen). It would be obvious to one of ordinary skill in the art at the time of the invention to combine Costales' method of conveying

Art Unit: 2141

electronic information to members of a defined group with Siitonen's step of storing the common information in the dynamic memory of a PDA, for the advantage of portability (Abstract).

Claim(s) 38: Costales teaches the handheld computer of claim 37, but fails to teach the remote location is another handheld computer.

Siitonen, in an analogous art, teaches a PDA using an E-mail application (Abstract and FIG. 5B of Siitonen). It would be obvious to one of ordinary skill in the art at the time of the invention to combine and use Costales' e-mail system with Siitonen's PDA, for the advantage of portability (Abstract).

### ***Conclusion***

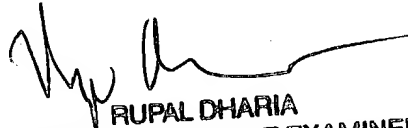
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tan Lien whose telephone number is (703) 305-6018. The examiner can normally be reached on Monday-Thursday from 8:30am to 6pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia, can be reached at (703) 305-4003. The fax phone number for this Group is (703) 305-3718.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [tan.lien@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
RUPAL DHARIA  
SUPERVISORY PATENT EXAMINER